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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/068,843	02/11/2002	Masanori Mukai	1080.1108	8975

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EXAMINER

RODRIGUEZ, JOSEPH C

ART UNIT	PAPER NUMBER
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3653

DATE MAILED: 08/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/068,843

Applicant(s)

MUKAI, MASANORI

Examiner

Joseph C Rodriguez

Art Unit

3653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Final Rejection

Applicant's arguments filed 6/12/03 have been fully considered but they are not persuasive for reasons detailed below.

The 35 U.S.C. 112 rejections are maintained or modified as follows:

Claims 1-9 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, the previous Office Action stated-

the claim language "[a] paper processing device which comprises" (ln. 1) and "the paper processing device comprising" (ln. 12) renders the invention unclear as it is uncertain if the first descriptive portion is meant merely as a preamble, or otherwise. Examiner requests clarification.

Applicant's changing of the word "comprises" to "includes" (ln. 1) does not clarify the issue as it is still unclear what features are part of a claim preamble or are actual claimed features. Examiner again requests clarification.

Claim 1 recites the limitations "the sensing" (ln. 3) and "one process" (ln. 5).

There is improper antecedent basis for these limitations in the claim.

Here, the claim language "one process" (claim 1, ln. 5) renders the claim scope indefinite. It is unclear what scope is being defined by the language "one process" as Applicant has defined multiple processes (e.g., discriminating process, ln. 3, and detecting process, ln. 9) and the relationship between these multiple processes is unclear. Examiner requests clarification.

Art Unit: 3653

The prior art rejections are maintained or modified as follows:

Claims 1, 2 and 4-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Sugai et al. ("Sugai")(US '249).

As previously stated:

Sugai teaches a paper processing device (Fig. 1-20) comprising a discriminating portion with sensors (313a-313g, 312a-312g), transfer routes (near 309-311), a sensor output abnormality detecting portion (331, 332), and a transfer control portion (330). Here, the transfer route corresponding to the specified abnormal status can be regarded as the normal dispensing or depositing route as the device continues operation although an abnormal sensor has been detected as the use of alternate sensors, or the subsequent cleaning of the sensors, allows continued operation (col. 18, ln. 36 et seq.).

Regarding claims 2 and 4-6, these claims merely consist of functional language and, moreover, the device taught by Sugai is regarded as capable of functioning as claimed. Applicant is respectfully reminded that claim language consisting of functional language and/or intended use phrasing is given little, if any, patentable weight as the apparatus must merely be capable of functioning, or being used, as claimed. See MPEP 2112.02, 2114. Further, the object worked upon by an apparatus (i.e., mock papers) does not render an apparatus patentable. See MPEP 2115.

Applicant's arguments that Sugai does not anticipate the claimed invention are unpersuasive. In particular, Applicant's argues for limitations that are incommensurate with the scope of the claims. For example, Examiner requests Applicant to precisely point out what part of the claim limitation establishes that "sensor cleaning and transaction processes are performed in parallel" as Examiner is unable to find language regarding "sensor cleaning" that Applicant repeatedly uses when attempting to distinguish the Sugai reference. These arguments, as the one above, are not germane to a determination of patentability. Applicant is reminded to focus on the actual claimed

limitations or to include the argued limitations in the claimed subject matter.

Consequently, Applicant's claims stand rejected.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sugai in view of what is well known in the art as demonstrated by Goto et al. ("Goto") (JP '456) and Applicant's Admissions.

As previously stated--

Sugai as set forth above teaches all that is claimed except for expressly teaching using a line sensor as the discriminating sensor. This feature, however, is well-known in the paper processing arts. For instance, Applicant (Spec., p. 1) and Goto (Abstract) teach the use of a line sensor when distinguishing papers during processing. Moreover, these sensors offer finer measurements than traditional optical sensors. Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the invention of Sugai as taught above.

Applicant's arguments that Goto does not anticipate the claimed invention are unpersuasive. In particular, Applicant again argues for limitations that are incommensurate with the scope of the claims. For example, Examiner requests Applicant to precisely point out what part of the claim limitation establishes that "sensor cleaning and transaction processes are performed in parallel" as Examiner is unable to find language regarding "sensor cleaning" that Applicant repeatedly uses when attempting to distinguish the Goto reference. These arguments are not germane to a determination of patentability. Applicant is reminded to focus on the actual claimed limitations or to include the argued limitations in the claimed subject matter. For example, if by "one process", Applicant actually means "a cleaning process" then the

claims should state this exact language. This highlights the importance of establishing proper antecedent basis and a definite claim scope. Therefore, as Applicant's claims are anticipated by the prior art, Applicant's claims stand rejected.

Claims 1 and 3 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Ono et al. ("Ono")(US '937) in view of Nei et al. ("Nei")(JP '984).

As previously stated—

Ono (col. 7, ln. 18-col. 8, ln. 45) teaches all that is claimed except for expressly teaching the continued operation of the device during abnormal sensor detection by using a pool portion to temporarily hold the abnormal papers. Nei, however, teaches the use of a pool portion (i.e., temporary holding portion 42-44) and, moreover, expressly teaches that this feature allows for the continued operation of the device during machine malfunctioning (Abstract). Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the abnormal sensor detection system of Ono with the pool portion taught by Nei to eliminate the device processing down time normally experienced during abnormal sensor detection (i.e., malfunctioning) in Ono's device.

Applicant's arguments that the above combination does not anticipate the claimed invention are unpersuasive. Here, Applicant focuses on deficiencies in the Ono reference that are remedied by the Nei reference. Nei, as cited above, expressly teaches for a machine to be in continuous operation despite an abnormal sensor—the essence of Applicant's invention. Consequently, as Applicant has failed to properly distinguish the prior art, Applicant's claims stand rejected.

Examiner has maintained the prior art rejections, statutory rejections and drawing objections as previously stated and as modified above. Applicant's amendment

necessitated any new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Conclusion

Any references not explicitly discussed above but made of record are considered relevant to the prosecution of the instant application.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph C Rodriguez whose telephone number is **703-308-8342**. The examiner can normally be reached on M-F during normal business hours (9 am – 6 pm, EST).

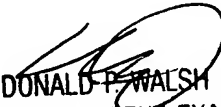
The examiner's **Personal fax number** is **703-746-3678**.

The **Official** fax phone number for the organization where this application or proceeding is assigned is **703-306-4195**.

The **UnOfficial** fax phone number for the organization where this application or proceeding is assigned is **703-306-2571 or 703-308-6552**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **703-308-1113**.

August 11, 2003


DONALD P. WALSH
SUPERVISORY PATENT EXAMINER
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